

REMARKS

As a preliminary matter, claim 20 is objected to based on the reasons set forth on page 2 of the Office Action. Applicants amend claim 20, as indicated herein, and Applicants believe that the Examiner's objection to claim 20 is obviated.

Claims 1-24 are all the claims pending in the present application. Claims 3, 4, 14, 15, 17, 21, and 24 are withdrawn from consideration. The previous rejection of claim 6 under 35 U.S.C. § 101 has been withdrawn. However, the Examiner maintains the prior art rejections. Claims 1, 2, 5, 6, 12, 13, 16, 20, and 23 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Koreeda (US Patent No. 5,890,137) in view of O'Leary (US Patent No. 6,609,113). Claims 7, 9-11, 18, and 22 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Koreeda in view of Dogac (Dogac, Asusman, Ozsü, M. Tamer & Ulusoy, Ozjur. Current Trends in Data Management Technology. Idea Group Publishing, Hershey, PA. 1999. pp. 41-42) and Davis (Davis, Steven. Pragmatics: A Reader. Oxford University Press. New York, New York. 1991. pp. 217-219). Claims 8, 9, and 19 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Koreeda, Dogac, and Davis, and in further view of Lomax (Lomax, Paul. *Learning VBScript*. O'Reilly & Associates, Inc. Sebastopol, California. 1997. pp. 457-459).

§103(a) Rejections - (Koreeda / O'Leary) - Claims 1, 2, 5, 6, 12, 13, 16, 20 and 23

Claims 1, 2, 5, 6, 12, 13, 16, 20 and 23 are rejected for the reasons set forth on pages 2-9 of the present Office Action, and adds a few new arguments in the *Response to Arguments* section of the present Office Action.

In the previous Amendment, Applicants argued that that it would not have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Koreeda based on the teachings of O'Leary, to arrive at the present invention, as nowhere does O'Leary disclose or suggest user-information storage means and/or purchase instruction receiving means that constitute an agent device. The wallet 215, which allegedly corresponds to the claimed agent device, is simply software that can be downloaded and installed from a website at a user terminal. See col. 9, lines 8-20 of O'Leary. The wallet that is disclosed in O'Leary clearly is not related to an agent device. Therefore, at least based on the foregoing, Applicants submit that independent claim 1 is patentably distinguishable over the applied references, either alone or in combination.

In response, the Examiner alleges:

First, O'Leary's software is non-functional without an accompanying device, such as a user terminal, upon which to operate. This is the same situation presented by the instant applicant, as the claimed computerized devices would be equally non-functional without some software providing the devices with functionality. The software component and the hardware component, the device, are inextricably linked, and, therefore, O'Leary does relate to an agent device, a user terminal.

Second, "one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references." *In re Keller, Terry, and Davies*, 208 USPQ 871, 882 (CCPA 1981). Furthermore, "[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; not is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller, Terry, and Davies*, 208 USPQ 871, 881 (CCPA 1981).

Therefore, regardless of the presence or absence of an agent device in the secondary reference, the potential lack of an agent device in O'Leary does not invalidate a finding of obviousness, as O'Leary should be judged upon the basis of "what the combined teachings of the references would have suggested to those of ordinary skill in the art", not whether each prior art reference consisted of a device. As O'Leary discloses the storage of user information, extraction of the user information and transmission of the user information during merchant transactions, the

possible lack of an agent device within O'Leary is immaterial, as the teachings are key.

In response, Applicants submit that even if, *arguendo*, the wallet 215 set forth in O'Leary relates to some sort of agent device, there is no teaching or suggestion in O'Leary or Koreeda that an agent device would include, "user-information storage means...", "purchase-instructions receiving means...", "user information extraction means...", "second purchase-instruction sending means ...," and "settlement requesting means..." as recited in claim 1. That is, the wallet 215, which is software that can be downloaded and installed from our website, is not an agent device. However, the Examiner only shows what he believes constitutes the wallet, or software. There is no disclosure or suggestion of the specific claimed elements set forth in claim 1 that constitute the claimed agent device. Therefore, at least based on the foregoing, Applicants submit that independent claim 1 is patentably distinguishable over the applied references, either alone or in combination.

Yet further, Applicants were not attacking individual references in the previous Amendment, but was simply responding to specific allegations of the Examiner about what the individual references disclose. In responding directly to the Examiner's assertions, Applicants addressed the specific references that were cited as allegedly satisfying specific limitations. However, Applicants maintain that neither of the applied references, either alone or in combination, satisfy the specific features set forth above.

With respect to independent claim 6, Applicants submit that this claim is patentable at least based on reasons similar to those set forth above with respect to claim 1. Yet further, as indicated above, the Examiner only discusses what he believes constitutes the wallet 215 of

O'Leary, and does not identify elements that correspond to the claim elements that constitute the claimed agent device. Therefore, the Examiner has not demonstrated that the applied references, either alone or in combination, satisfy the operation of preregistering ID information of a user, information regarding the user, and information regarding settlement means held by the user in association with each other in a database of the agent device. Therefore, at least based on the foregoing, Applicants maintain that claim 6 is patentably distinguishable over the applied references, either alone or in combination.

Applicants submit that independent claim 16 is patentable at least based on reasons similar to those set forth above with respect to claims 1 and 6.

Applicants submit that independent claims 12, 13, 20 and 23 are patentable at least based on reasons similar to those set forth above with respect to claim 1. Applicants submit that dependent claims 2 and 5 are patentable at least by virtue of their dependencies from claim 1.

§103(a) Rejections (Koreeda/Dogac/Davies) - Claims 7, 10, 11, 18 and 22

With respect to claim 7, 10, 11, 18 and 22, Applicants previously argued that one of ordinary skill in the art would not have been led to combine Davis with Koreeda and/or Dogac, to arrive at the present invention. Davis is simply an article related to pragmatics and linguistics (specifically, responding to indirect speech acts), whereas Koreeda and Dogac are directed to technical inventions (e.g., Koreeda is directed to an online shopping system).

In response to this argument, the Examiner alleges:

In response to Applicants' arguments concerning the §103 rejection of claims 7, 10, 11, 18 and 22, specifically Applicants' argument that Davis, as "an article related to pragmatics and linguistics", is non-analogous art when considered in conjunction with Koreeda and Davis, related to technical inventions, Examiner respectfully disagrees. (see Applicants' argument, page 25).

It has been held that the determination that a reference is from a non-analogous art is two-fold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood and Eversole*, 202 USPQ 171, 174 (CCPA 1979).

In the instant case, claimed language related to determining the merchant-specified settlement means and Davies was brought in for the limited purpose of demonstrating that determining and/or inquiring the settlement means accepted by a specified merchant is old and well known in the art. While Davies is a textbook related to linguistics, the fact that a textbook published ten years prior to the Applicants' invention dedicated a section to contacting merchants to inquire about acceptable settlement means, such as accepted credit cards, should demonstrate that such inquiries and/or determinations are old and well known in the art.

Furthermore, as inquiring and/or determining the merchant-specified settlement means is old and well known in the art, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Koreeda and Dogac to allow for a standard practice and/or procedure in conducting merchant transactions.

In response, Applicants maintain the previous arguments, and submit that an individual inquiring about what form of payment a store may take, would not have led one of ordinary skill in the art to combine Davis with the applied references to produce a device (not another human) that contains means for extracting information regarding a product to be purchased from contents of a browsed merchant site and information regarding specified settlement means. The Examiner has made an unsupportable leap in contending that one of ordinary skill in the art would have combined these two separate references, without teaching or suggestion of the above in any of the applied references. Therefore, at least based on the foregoing, Applicants maintain that one skilled in the art would not have been motivated to combine the applied references, and Applicants respectfully request that the Examiner withdraw the rejections of claims 7, 10, 11, 18, and 22.

§103(a) Rejections - (Koreeda / Dogac / Davis / Lomax) - Claims 8, 9 and 19

Applicants submit that claims 8, 9 and 19 are patentable at least by virtue of their respective dependencies from independent claims 7 and 18. Lomax does not make up for the deficiencies of the applied references.

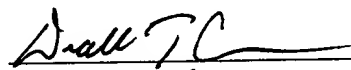
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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